

Application No. 10/692,917

Reply to Office Action

*REMARKS**Discussion of Claim Amendments*

Claims 1, 14, and 15 have been amended to exclude tetrabutylammonium tetrafluoroborate as a hydrophobic conductive agent. The amended claims are supported by the original claims and specification, e.g., paragraph [0023] at page 26. As applicants have disclosed a genus and species, they ought to be able to claim the genus minus a disclosed species. See, e.g., *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). No new matter has been added.

The Office Action

The Office Action sets forth the following grounds for rejection:

1. Claims 1, 5-10, 12-18, 20-21, 23, and 25-26 are provisionally rejected under the doctrine of obviousness-type double patenting, as allegedly unpatentable over claims 1, 8, 11-15, 38, 42, 53, and 55-57 of copending Application No. 10/314,163 in view of Zhu et al. '933 (USP 6,221,933);
2. Claims 1, 5-10, 12-18, 20-21, 23, and 25-26 are provisionally rejected under 35 USC § 103(a), as allegedly unpatentable over copending Application No. 10/314,163;
3. Claims 1-3, 5-15, 17, and 20-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. (USP 5,596,027) and Marshall et al. (USP 5,275,646);
4. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. and Marshall et al. and further in view of Wu et al. (US 2003/0144375);
5. Claims 1-3, 5, 7, 12-15, 17-22, and 25-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. (US 2003/0227531) in view of Marshall et al.;
6. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Marshall et al. and further in view of Santilli et al. (USP 5,738,716);
7. Claim 6 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Marshall et al. and further in view of Zhu et al. '933;
8. Claims 8-11 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Marshall et al. and further in view of Mead et al.;

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9. Claims 1-3, 5-15, 17, and 20-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. and Zhu et al. '868 (US 2004/0110868);

10. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Zhu et al. '933 in view of Mead et al. and Zhu et al. '868 and further in view of Wu et al.;

11. Claims 1-3, 5, 7, 12-22, and 25-26 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '868;

12. Claim 4 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '868 and further in view of Santilli et al.;

13. Claim 6 is rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '868 and further in view of Zhu et al. '933; and

14. Claims 8-11 are rejected under 35 USC § 103(a), as allegedly unpatentable over Hosoi et al. in view of Zhu et al. '868 and further in view of Mead et al.

Discussion of Rejections

1. Provisional Obviousness-Type Double Patenting Rejection (Ground 1)

Applicants note that the rejection is provisional. Accordingly, Applicants wish to defer providing a more substantive response on this rejection until an actual rejection is made.

2. Provisional Obviousness Rejection (Ground 2)

The provisional obviousness rejection is over the '163 application. The '163 application has published as Zhu et al. '868 and qualifies as prior art only under 35 USC § 102(e), (f), or (g). Applicants herein provide a statement of common ownership to disqualify the '163 application as prior art under 35 USC § 103(c).

Statement of Common Ownership

The present application and the '163 application were, at the time the invention of the present application was made, owned by Videojet Technologies Inc.

In view of the foregoing, the '163 application should be removed as prior art. Accordingly, the obviousness rejection should fall.

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3. Obviousness Rejections Citing Marshall et al. (Grounds 3-8)

As applicants have amended independent claim 1 to remove tetrabutylammonium tetrafluoroborate, all these rejections should fall. Claim 13, which is generic, depends upon and includes the limitations of claim 1. Therefore, claim 13 should not be read to cover tetrabutylammonium tetrafluoroborate. The conductive agents disclosed in Marshall et al. at column 4, lines 43-52, other than tetrabutylammonium tetrafluoroborate, are hydrophilic. "Hydrophilic" cannot suggest, to those of ordinary skill in the art, just the opposite, namely, hydrophobic. Therefore, Marshall et al. fails to suggest the hydrophobic conductive agents presently recited. Zhu et al. '933, Hosoi et al., Mead et al., Wu et al., and/or Santilli et al. fail to suggest the presently claimed invention. In view of the foregoing, the obviousness rejections should be withdrawn.

4. Obviousness Rejections citing Zhu et al. '868 (Grounds 9-14)


As discussed, the Zhu et al. '868, which published from the '163 application, qualifies as prior art only under 35 USC § 102(e), (f), or (g). See statement of common ownership above.

In view of the foregoing, Zhu et al. '868 should not be applied as prior art under 35 USC 103(c). The remaining references fail to suggest to those of ordinary skill in the art the presently claimed invention. Accordingly, the obviousness rejections should be withdrawn.

Conclusion

A favorable decision is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: February 24, 2006